

## REMARKS

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

Claims 1, 9 and 11 have been amended. Support for the amendments can be found in the specification at page 3, line 31 to page 4, line 1; page 5, lines 7-15; page 4, lines 13-17; and page 7, lines 6-15.

No new matter has been added.

### Election/Restrictions

While noting that the election requirement has been made final, Applicants continue to pursue the species of claims 1-25 as shown in Figures 1-9. It is submitted that the subject matter of claim 1 is novel over the prior art. Claims 2-25 are all dependent on claim 1, and hence, include the limitation of a device comprising a tip portion, a bend, and a shank, wherein the tip portion comprises a tube of a non-pliable material having a sharpened end, and the bend is formed from a pliable material.

Applicants submit that withdrawn claims 18-23 also include these limitations of claim 1, and add further limitations thereto, namely that the device may include a plurality of hooks as recited in independent claim 1. Accordingly, the claims do possess the same technical feature and hence relate to a single general inventive concept under PCT Rule

13.2. Applicants request that upon allowance of claim 1, the Examiner reconsider claims 18 to 23 which are dependent upon claim 1.

It is respectfully submitted that the claimed device is far from being the fish hook asserted against the claims in the Office Action dated March 31, 2009.

**Rejection under 35 USC § 112, second paragraph**

The Examiner has rejected claims 1-17, 24, and 25 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claim 1 by deleting the limitation "said tube bore", and as such, submit that the rejection thereof is now moot.

The Examiner's 35 U.S.C. § 112, second paragraph, rejection of claims 1-17, 24 and 25 further predicates on his contention that the term "non-pliable" in claim 1 is a relative term which renders the claim indefinite (paragraph 11). The Examiner asserts that the term "is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention".

The Applicant's respectfully point out that the specification does indeed provide a standard for ascertaining the requisites degree of rigidity to constitute non-pliability. The Examiner's attention is directed to page 3, lines 15 to 21 of the application where the following is stated:

"However, the tip portion can be fabricated from any suitable material such as a

plastic, glass or ceramic material meeting the following requirements:

- it will not be deformed when in use (that is, it is sufficiently hard); and
- it can be machined to provide an end with sufficient sharpness for penetrating flesh on the inside or outside of the mouth of a fish."

Applicants submit that one of ordinary skill in the art would be apprised of the scope of the invention as defined in the claims, particularly as defined in amended claim 1. Specifically, claim 1 now recites that the bend is formed from a pliable material of sufficient rigidity so that the sharpened end of the tip portion contacts the flesh of the fish at the time of an initial strike on the device but is sufficiently pliable to straighten under the action of the fish and/or force applied via the line attached to the device. One of ordinary skill in the art would recognize that the non-pliability (i.e., rigidity) of the material comprising the tip portion is such that the sharpened end of the tip portion contacts the flesh of the fish and captures the biopsy. That is, a person of ordinary skill in the art would recognize that the tip portion comprises a material that in use of the device cannot be bent, whereas the bend of the device comprises a material that in use can be bent. Indeed, for the device to function as intended, the bend has to straighten.

In the light of the foregoing, Applicants submit that claims 1-17, 24 and 25 are fully in compliance with 35 U.S.C. § 112, second paragraph.

The Examiner has further rejected claims 1-17, 24, and 25 under 35 U.S.C. 112, second paragraph, stating that the term "optionally includes a plurality of barbs" in claim 1 is a relative term which renders the claim indefinite. For purposes of expediting allowance

of the foregoing application, this limitation has been omitted from the claim thereby making the rejection thereof now moot.

Claim 9 has been amended to recite that the tip portion (of the device of claim 1) includes at least one member projecting into the bore of the tip portion from the end that adjoins the bend of the hook, wherein said at least one member is barbed. The asserted omitted structural cooperative relationships—or at least a relationship—is thus now recited in claim 9. It is also submitted that the Examiner's position taken in paragraph 24 is unnecessary in the light of the amendment of that claim. Accordingly, applicants request that the rejection of claim 9 be withdrawn.

It is respectfully submitted that the rejection of claims 1-17, 24, and 25 under 35 U.S.C. 112, second paragraph, are now moot.

No new matter has been added.

#### **Rejection under 35 USC § 102**

The Examiner has rejected claims 1-17, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rand, Jr. (US 4,543,742, hereinafter Rand).

Applicants disagree and submit that the Examiner's analysis of claim 1 in the light of what is disclosed in Rand is rendered irrelevant in view of the amendments made to the pending claims. The limitation that readily distinguishes applicants' claimed device from Rand—in addition to other features—is the bend portion of the device as is recited in independent claim 1, and which will now be elaborated in more detail below.

In the last dot point of paragraph 27 in the above-identified office action the Examiner states that "the bend is formed from a second material having a second flexibility greater than the first flexibility [of the material comprising the tip portion (fourth dot point)]", which feature can be found in Rand. Applicants respectfully submit that the Examiner's interpretation of Rand has resulted from an incorrect interpretation (as enunciated in paragraph 16 of the Action) of the claimed limitations of the instant application.

Applicants submit that the instant claimed device should not merely be interpreted as to whether the material of the tip portion has a flexibility, which is different to the flexibility of the material comprising the bend. What is required, and is now positively recited in independent claim 1, is that the bend is formed from a pliable material of sufficient rigidity so that the sharpened end of the tip portion contacts the flesh of the fish at the time of an initial strike on the device, but is sufficiently pliable to straighten under the action of the fish and/or force applied via the line attached to the device to disengage the tip portion and free the fish. It is thus implicit in the language of the claim that the tip portion, as pointed out above, is of a rigidity that a biopsy is obtained when the sharpened end of the portion contacts the flesh of the fish.

It may be that the equivalents of the tip portion and the bend in the fish hook disclosed in Rand are of differing flexibilities. However, what is not disclosed in Rand is a bend formed from a material that will straighten when the hook is struck by a fish. To the contrary, the Rand hook must retain its bent form to allow liquid to be ejected from the sharp end when a fish strikes the hook.

Applicants submit that Rand is limited to disclosing permanently bent hooks. Applicants further submit that if the hooks disclosed in Rand were not permanently bent, then such hooks would not be able to hook and capture fish as is disclosed in Rand. (See, for example, Rand, Abstract.)

In view of the foregoing, it is respectfully submitted that Rand does not anticipate claim 1 because Rand does not disclose, or even suggest, a device comprising a bend formed from a material that can straighten on being struck by a fish. Since Rand does not anticipate the limitations of claim 1, it is submitted that Rand also does not anticipate dependent claims 2-25 which comprise at a minimum the limitation that the bend is formed from a pliable material of sufficient rigidity so that the sharpened end of the tip portion contacts the flesh of the fish at the time of an initial strike on the device but is sufficiently pliable to straighten under the action of the fish and/or force applied via the line attached to the device to disengage the tip portion and free the fish.

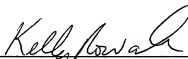
Accordingly, applicants submit that Rand does not anticipate claims 1-17, 24 and 25, and as such, also does not anticipate claims 18-23. It is therefore respectfully requested that the 35 U.S.C. § 102(b) rejection of the claims be withdrawn.

Applicants have amended claims 1, 9 and 11 in this application. Applicants are not conceding in this application that the claims as they stood prior to amendment are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution and allowance of the claims. Applicants respectfully reserve the right to pursue these prior and other claims in one or more continuation and/or divisional patent applications.

Applicants would also like to point out that the claims of the subject application have received a favorable report as to novelty and inventiveness from both the International Preliminary Examination Report on the international application (PCT/AU2003/001609) and a communication in respect of a regional phase application in Europe (03 812 103.4).

It is respectfully submitted that the application has now been brought into a condition where allowance of the entire case is proper. Reconsideration and issuance of a notice of allowance are respectfully solicited.

Respectfully submitted,

  
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